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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,398	11/28/2001	Jai K. Baek	212/340	3095

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

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DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,398

Applicant(s)

BAEK

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-7, 9-16 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcher 4,702,022 in view of Dalvy et al. 5,924,218 and Mashita et al. 5,681,649. Porcher discloses all the limitations substantially as claimed including the following: a liner with multiple resilient layers (see Figure 3A especially, showing an inner liner, a resilient layer on top of the inner liner; a second resilient layer on top of the first resilient layer, and at least an outer cover layer, all shown in the heel and forefoot areas.). All the layers of the liner boot, including the vacuum layer, are provided to make the boot more comfortable on the user's foot and to protect the user's foot during use. Porcher '022 does not disclose a gel pad located between any of the layers in the toe box area or the heel area. Dalvy et al. '218 teaches that a gel pad 5 can be

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located between the layers of an inner boot (especially in the heel area as shown in Figure 1) to aid in protecting the user's foot and to help in cushioning the user's foot and fitting the boot to the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, in view of Dalvy et al. '218, to place a gel pad in the heel area of the liner of Porcher '022 to aid in protection and comforting the user's foot within the boot. Mashita et al. '649 teaches that a gel pad, made of styrene and butadiene, can be located in many areas of footwear including the toe box area, to aid in cushioning and protecting the user's foot. Therefore, it would have been obvious to place a gel pad in the toe box area, as taught by Mashita et al. '649, between any of the layers of the toe box to aid in cushioning, protecting and comforting the user's foot within the boot. With respect to the different Shore A hardnesses of the toe box and heel counter, it appears that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot.

Response to Arguments

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3. Applicant's arguments filed July 2, 2003 have been fully considered but they are not persuasive. Applicant argues that the arrows that applicant has placed on Figure 3A of Porcher '002 has been shown in the Figure but not described by Porcher '002 and that this denotes a resilient layer and a vacuum layer and not two layers of resilient material. This argument is not clearly understood. As noted in Figure 4a and 4b (the same as Figures 3a and 3b only in the closed position), layers 40 and 41 are located in the front area of the boot and travel to the toe area as show in the side view of Figure 4b. Therefore, there are two layers present in the claimed areas. Admittedly, there is a vacuum 5 in the boot that forms the folds 6a and 6b of Porcher '002, but these layers 40 and 41 are located within the vacuum so that when the boot is closed, the walls of the vacuum chamber penetrate into the space between 40 and 41 of spongy lining. Even if only one layer of material were present in the vacuum, there would still be two layers present, one of the spongy material and one of air. Clearly from Figures 3b and 4b it can be seen that the layers shown in Figures 3a and 4a continue into the toe area of the boot. If Porcher '002 meant for the section with the holes shown located within it to be the vacuum, then Porcher '022 would have noted such in Figure 2 where it is clear that Porcher '002 is not directing the vacuum

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5 to be the area with the hole located therein. With respect to applicant's arguments directed to the combination of Porcher '002 and Dalvy et al. '218, applicant argues that placing the pad of Dalvy et al. '218 within the boot of Porcher '002 would not allow the pad to conform to the user's foot because warm air would not diffuse through the pad to aid in weakening it to be moldable. This argument is also not clear. The material of the boot of Porcher '002 is not made up of any different material than that of Dalvy et al. 218 which would allow the warm air to diffuse through the pad. A pad can conform to the shape of a user's foot without being adjacent to the user's foot when the material that is adjacent to the user's foot can conform to the shape of the user's foot. With respect to the combination of Porcher '002 and Dalvy et al. '218, the material closest to the user's foot would be a lining that is extremely flexible and once a conformable material next to that lining is pressed against the lining with the lining pressed against the user's foot, the conformable material will conform to the shape of the user's foot as will the lining. With respect to the applicant's arguments directed to Mashita et al. 649, these too are not clearly understood. Applicant argues that Mashita et al. '649 does not provide any indication of where his pad should be located and therefore the combination is not rendered obvious.

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Mashita et al. '649 teaches that the pad can be placed wherever necessary to aid in cushioning the impact to a user's foot. Therefore, wherever the pad would contribute to cushioning the impact to the user's foot, either within the lining, between other pads, etc., it would have been obvious to one of ordinary skill in the art to place the pad wherever necessary to aid in cushioning a desired area of the foot. Applicant argues that there is no indication in the art that shows that making a boot of a particular hardness is a "mere" matter of testing and optimization. This argument is unclear. It is well known throughout the art of making boots that certain areas of impact of the user's foot with the ground would need more cushioning, better support, and harder material for wear and abuse than other areas that do not see the same stresses, pressures and usage. A person of ordinary skill in making boots who desires to have a toe area that does not compress under a desired load would be able to determine what material and how thick that particular material would have to be to prevent such a compression. Applicant further argues that the combination of the references is improper because there is no specific motivation stated in the references to combine the references. This argument is not clearly understood. The motivation to combine references can come from the references themselves, what

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the references teach together as a whole, or from the knowledge of one of ordinary skill in the art. Since all the references include the idea of improving cushioning a user's foot within the shoe. There references are properly combinable for such a reason, as stated in the rejections. Applicant further argues that none of the references provide any indication that one would benefit from the other. Since such direct statements are not required and the benefit of better cushioning to the user's foot is at least part of a problem solved by all, either explicitly or inherently, the references are properly combinable.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
September 19, 2003